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REMARKS

Applicants request reconsideration and allowance of the present application in view of the foregoing amendments and the following remarks.

Claims 44-57 are now pending in the present application. Claims 44, 56, and 57 are the independent claims.

Claim 57 is newly presented. No new matter has been added.

Claims 42-55 stand rejected under the second paragraph 35 U.S.C. 112 as indefinite. In particular, the Office Action contends that the respective features added to the independent claims in the last response are somehow indefinite (*Office Action*, page 2). This rejection is respectfully traversed.

A claim satisfies the definiteness requirement of the second paragraph of 35 U.S.C. 112 when it sets out and circumscribes an invention with a *reasonable* degree of precision and particularity. (*MPEP* §2173.02 (*emphasis in original*)). And, breadth of a claim is **not** to be equated with indefiniteness. (*MPEP* §2173.04, citing *In re Miller*, 441 F.2d 689, 169 USPQ 597 (CCPA 1971)). Rather, when the scope of a claim is clear, and if applicants have not otherwise indicated that they intend the invention to be of a scope different from that defined in the claims, then the definiteness requirement of 35 U.S.C. 112 is satisfied.

Applicants respectfully submit that:

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the Office has again failed to articulate a *prima facie* case since it does not explain how the scopes of the rejected claims as presented are unclear to one of ordinary skill in the art; the scopes of the rejected claims are clear; and the Office Action itself buttresses this conclusion.

Firstly, the Office only questions how one is to accomplish the claimed invention, **not the scope** of what is claimed. For example, the Office presents questions about "how this is accomplished" and "what regions ... form the capacitors." These questions about how to make a claimed invention are *inapposite* to any definiteness inquiry since this requirement seeks only to ensure that the scope of the claims is clear (MPEP §2173). Stated another way, the Office has not articulated a proper basis to challenge the definiteness of the rejected claims.

Secondly, the rhetorical questions presented at page 2 of the Office Action evidence of the certainty of the scopes of the rejected claims. After all, the Office must surely understand the scope of a claimed invention if it is to question how to accomplish it.

Lastly, to the extent that the Office is requiring further recitations of the specific structure of the electrostatic protection elements to satisfy the definiteness requirement of § 112, Applicants remind the office that breadth of a claim does not equal indefiniteness. (MPEP 2173.04). Consequently, any requirement for further recitation is without basis in law or fact.

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In sum, the claims are sufficiently clear in scope, thus the **definiteness** requirement is met. Accordingly, favorable reconsideration and withdrawal of the rejection under 35 U.S.C. § 112 are respectfully requested.

Claims 44 to 56 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,556,409 (*Chittipeddi et al.*) in view of conventional input circuit illustrated in FIG. 14 of Applicants' disclosure (the conventional input circuit) and U.S. Patent No. 6,154,388 (*Oh*). This rejection is respectfully traversed.

Claim 44 continues to recite, *inter alia*, a plurality of electrostatic protection elements ... each electrostatic protection element including two transistors each of which forms part of a respective capacitor.

Claim 56 continues to recite, *inter alia*, electrostatic protection elements, ... each ... including two transistors ... and that transistors of a same type and of respective electrostatic protection elements form respective capacitors.

By at least these claim features, particular capacitors are provided. These capacitors have transistors of different alleged electrostatic protection elements. Also, particular electrostatic elements are provided. These electrostatic elements have transistors that are each part of different, respective capacitors.

Applicants respectfully submit that neither of the asserted documents teaches or suggests at least the aforementioned

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features. Accordingly, without conceding the propriety of the asserted combination, it is submitted that the asserted combination is likewise deficient, even in view of the knowledge of one of ordinary skill in the art.

Briefly, *Chittipeddi et al.* is silent as to the structure of any alleged electrostatic protection elements. Further, the conventional input circuit discusses a single electrostatic protection element the transistors of which form a single capacitor. And, *Oh*, cited for allegedly showing the state of the art, does not teach or suggest anything that remedies the deficiency in the combination of *Chittipeddi et al.* and the conventional input circuit.

The primary citation to *Chittipeddi et al.* discusses two integrated circuits 5 and 10 each of which include I/O circuitries 15 and 20 that may have electrostatic discharge (ESD) protection components (*Chittipeddi et al.*, Fig. 1a, col. 3, lines 44-51).

Chittipeddi et al., however, still does not teach or suggest an electrostatic protective element *as defined by the claims*. That is, an electrostatic protection element that includes two transistors each of which forms part of a respective (different) capacitor. Again, this silence is not surprising since this patent seeks to provide selective ESD protection. (*Chittipeddi et al.*, Abstract).

Thus, the primary citation still does not teach or suggest the aforementioned claim features.

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The secondary citation to the conventional input circuit includes transistors that include a capacitor that is an electrostatic protection element. (*Applicants' specification*, page 2, lines 1-5; Fig. 14). It still fails, however, to teach or suggest either: (1) transistors of an electrostatic protection element forming parts of different capacitors; or (2) plural capacitors. These conventional capacitors do not meet the aforementioned claim features. Also, this absence is not surprising since the conventional input circuit only uses a single electrostatic protection element.

Thus, the secondary citation to the conventional input circuit also still does not teach or suggest at the aforementioned claim features, evening combination with *Chittipeddi et al.*

As for the tertiary citation to *Oh*, even assuming *arguendo* that the Office's characterizations of that patent are correct, *Oh* does not remedy the continuing deficiency in the combination of *Chittipeddi et al.* and the conventional input circuit.

Oh relates to a security circuit for semiconductor memory and a method of protecting stored data using the method. A review of the figures cited by the Office Action, FIGS. 1 and 2, reveal components that include transistors. These transistors, however, do not meet the aforementioned claim features since the transistors of different alleged electrostatic protection elements do not form part of respective (different) capacitors. Stated another way, there are no capacitors having transistors of different alleged electrostatic protection elements.

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Thus, Oh does not remedy the continuing deficiency in the combination of the primary and secondary citations.

Accordingly, favorable reconsideration and withdrawal of the rejection of the claims under 35 U.S.C. § 103 are respectfully requested.

Lastly, Applicants respectfully submit that newly presented claim 57 patentably defines over the cited art at least for the recitation of "a plurality of semiconductor chips, each semiconductor chip including ... an input pad, and that the input pads are commonly connected." This is at least because the asserted combination fails to even suggest either plural semiconductor ships or the common connection of the input pads of the semiconductor chips.

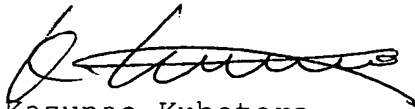
In view of the foregoing, Applicants respectfully submit that the independent claims patentably define the present invention over the citations of record. Further, the dependent claims should also be allowable for the same reasons as their respective base claims and further due to the additional features that they recite. Separate and individual consideration of the dependent claims is respectfully requested.

Applicants believe that the present Amendment is responsive to each of the points raised by the Examiner in the Official Action. However, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to such matters.

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There being no further outstanding objections or rejections, it is submitted that the present application is in condition for allowance. An early action to that effect is courteously solicited.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Kazunao Kubotera', written over a horizontal line.

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